

Appl. No. 09/935,895
Supplemental Response after Final Rejection
Reply to Office action of 30 December 2003

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REMARKS / DISCUSSION OF ISSUES

Claims 6-11 are pending in the application.

The Examiner continues to reject claims 6-8 and 10 under 35 USC § 103(a) over applicants' FIG. 3 in view of Saito et al. (JP 3-241801). Applicants traverse this rejection. All of the pending claims are patentable over any permissible combination under 35 U.S.C. §103(a) of the cited references, at least because:

1. The feature of independent claims 6 and 10 requiring a **spacer material of a synthetic resin that is substantially homogeneously distributed and has a concave surface** cannot read on the foil and adhesive "sandwich" represented in applicants' FIG. 3;
2. The Examiner has given presented no motivation for modifying the apparatus shown in applicants' FIG. 3 by replacing the foil and adhesive "sandwich" of FIG. 3 with the magnetic filling taught by Saito et al. (JP 3-241801); and
3. The Examiner has given no rationale at all for his assertion that such a combination would necessarily produce the recited homogeneously distributed resin having a concave surface.

A Response to the final Office action of 30 December 2003 was transmitted by facsimile on 16 February 2004. An Advisory Action was mailed in this case on 11 March 2004. The response of the Examiner to all of applicants' final response arguments is as follows, in its entirety: *"The prior art of record disclose the claimed invention."* All of applicants' repeated requests for the Examiner to provide any motivation for his proposed combination of references under 35 U.S.C. §103(a), or rationale for his assertions of inherency, have been ignored.

The Advisory Action gives no response to applicants' assertion that the examiner has not established inherency for his statement that the magnetic filling of Saito et al. "would inherently [form] a concave/convex surface" by providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art, as required by **MPEP 2112**.

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The Examiner continues to give no response to applicants' legitimate request, made in both the response to the first Office action and in the response to the final Office action, that the Examiner provide such evidence.

The Advisory Action gives no response to applicants' assertion that the Examiner is in violation of MPEP § 2144.03 and 37 C.F.R. §1.104(d)(2), as outlined in the response to the final Office action.

In contravention of MPEP 2144.03, the Examiner has not provided any evidence or affidavit under 37 C.F.R. §1.104(d)(2) required whenever an applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, as applicants have done.

In contravention of MPEP 2144.03 B, the Examiner has not provided any response to applicants' assertion that applicants have not been "presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made."

In contravention of MPEP 2144.02, the Examiner has not provided any evidentiary support for his statement that the magnetic filling of Saito et al. "would inherently [form] a concave/convex surface," upon applicants' request for such evidence, although applicants have timely requested such.

Further, the Examiner has ignored applicants' legitimate request that he provide any rationale at all for his assertion that one of ordinary skill in the art would have combined the cited reference with applicants' FIG. 3 "for the purpose of controlling the magnetic field of the device."

The Examiner has also given no rationale whatsoever and offered no proposed motivation for one of ordinary skill in the art to use the resin of Saito et al. in a two-gap core such as in Bizen et al., to attempt to satisfy the language of claims 9 and 11.

Furthermore, in contravention of MPEP 2125, the Examiner is relying on arguments based his own perception of a shape in a drawing figure to find a recited structural feature in an "admitted prior art" drawing, even though the specification itself, in describing that drawing figure, specifically contradicts that personal

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perception of the Examiner. In a telephone interview on 29 March 2004, Examiner Nguyen stated that he is relying not on the foil 3 of applicants' FIG. 3 alone, but on **the foil 3 and adhesive 4 combined**, to satisfy the requirement of independent claims 6 and 10 for a gap substantially filled with a spacer material of a synthetic resin that is substantially homogeneously distributed and has a concave surface. The specification specifically points out that this filler is neither homogeneous nor concave (page 6, lines 15-16). Yet the Examiner continues to insist that "a filler ... that is substantially homogeneously distributed in the first gap and has a concave surface" reads on the foil and adhesive "sandwich" represented in applicants' FIG. 3, based purely on a misperception of his own, thereby blatantly ignoring the structural limitations recited in the claim. Anyone of ordinary skill in any physical science or engineering art whatsoever, would agree that adhesive and foil are two very different substances, and therefore do not together form a homogenous substance: a filler comprising a foil plus the adhesive holding it within a gap, is not a substantially homogeneously distributed filler.

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance, **or at the very least provide a non-final Office action that clearly and comprehensively states his various rationale for the rejections of record, as he is required to do.**

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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